



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,737	08/10/2001	Fumio Tokutomi	212734US2	6661
22850	7590	03/05/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER QIN, YIXING	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 03/05/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/925,737	<b>Applicant(s)</b> TOKUTOMI ET AL.	
	<b>Examiner</b> YIXING QIN	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3, 7, 8, 11, 13, 15, 18, 20, 23, 26, 29, 32, 34-36 and 39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 7, 8, 11, 13, 15, 18, 20, 23, 26, 29, 32, 34-36 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

This action is in response to the Pre-Brief Appeal Conference decision on 12/26/07. This action is again made final because the prior art references used were decided to be reasonable in the rejection. The arguments needed more detail and/or clarification. KSR rationale has also been provided for why it would have been obvious to have created an in-store purchase and pick-up type of button. Please see below for more detail.

The amended claims call for the delivery option to be represented by a corresponding delivery button and the ability to have an in-store purchase and pickup option with the reservation of item.

Although the references do not explicitly disclose the above amendment, the representation of a particular option as a button is well-known. Since the Hayward reference already shows the usage of buttons in Fig. 4, the addition of another button would be obvious, especially since Hayward/Vallabh already discloses various ways for the user to obtain the item, so it would have been obvious to include buttons for the users to designate how the user wanted to receive the item.

**Under KSR rationale – applying a known technique to a known device ready for improvement to yield predictable results:**

Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

In the present application, it is known that there are a variety of ways to purchase an item and the representation of these ways electronically using a button would have been obvious given the fact that Hayward and Vallabh in combination discloses some of

the various ways to purchase the items by telling an electronic system what the preference of the user would be in the purchasing of an item.

As for the in-store purchase and pick-up option, even though it is not explicitly disclosed, going to the store and purchasing an item is arguably the oldest form of purchasing goods from a store. The claimed invention is essentially calling for a button to represent this act. Since both Hayward and Vallabh together disclose various buttons for other forms of purchasing acts, it would have been obvious to have included a button for a well known form of purchasing goods such as the in-store purchase and pick-up option.

The addition of such a button (for in-store purchase and pickup) would have been obvious because it would simply be representing another well known choice that can be made by a user. The results of the addition of this button would have been predictable because the user is notifying the system of a particular purchasing act (in-store purchase and pickup) that a user is going to perform.

Since both the usage of different buttons representing various purchasing options and the usage of a commonplace purchasing option has been known, it would have been obvious to one of ordinary skill in the art at the time of invention to have implemented an additional button to notify that a user wishes to perform an in-store purchase and pickup. This rejection is again made final.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 3, 7, 8, 11, 13, 15, 18, 20, 23, 29, 32, 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward et al (US 6,798,997) in view of Vallabh (US 7,054,832).

Regarding claim 3: Hayward et al. (US 6 798 997) teach a print apparatus consumable purchase system (column 1, lines 8-16) comprising: a print apparatus (column 4, line 10 & fig 2, peripheral 10) for printing on a print medium, a display capable of displaying information concerning the print apparatus (fig. 3 & column 5, lines 24-39, display screen for print apparatus purchase system displays information concerning the peripheral 10); and a controller for displaying a status screen (figs 3 & 4, & column 5, lines 23-24 & 62-63, a display screen is used to display screen associated With the status of the peripheral 10) for representing consumption degree of a consumable used with the print apparatus on the display (fig 3 & column 5, lines 23-39, the display includes an "X" indicator to indicate a status condition in peripheral 10, wherein, column 5, lines 6-7, status conditions in peripheral 10 indicate a need for consumable replacement, which, column 8, lines 26-31, is based off of consumable

level. In Specification, Applicant defines a consumption degree of a consumable as an "ink remaining amount." Therefore the indicator "X" taught by Hayward et al. and shown on the display in fig 3 represents an ink/toner remaining amount because it represents a low level) and displaying one (buy now, fig. 4) of a plurality of options (options to select buying from a preferred retailer, column 8, lines 60-65, options to buy now, options to have a diagnostics perform first before buying, column 7, lines 35-52, options to buy from a manufacturer, options to pay with a credit card, options for overnight express shipment, etc, column 8, lines 1-10) concerning the purchase mode (buying) of the consumable in the status screen (fig. 4), an option calling button (buy now button, column '8, lines 55-65) for calling the plurality of options concerning the purchase mode of the consumable in the status screen (column 8, lines 60-63)

NOTE: Although not specifically mentioned, a controller is inherently included in the system taught by Hayward et al. Without a controller, the functions associated with display of information as outlined above would not be available in the print apparatus consumable purchase system. Therefore the teachings of Hayward et al. inherently included a controller as outline above.

Hayward further teaches a plurality of options to be selected, by using browser display (column 7, lines 65-67), of delivery purchase option (column 8, lines 47-48) represented by a corresponding delivery button and an in-store purchase and pickup

option (column 8, lines 60-63, retailer is well known in the art to be in the form of a store, (official notice)).

**Again, under KSR rationale – applying a known technique to a known device ready for improvement to yield predictable results:**

Hayward does not show the screen of ordering through delivery purchase option and through a store (retailer) and the in-store purchase and pickup button for acquire a screen for providing dealer information and for reserving the consumable for in-store purchase from a selected dealer.

Vallabh, in the same area of online ordering (column 14, lines 35-40) teaches a screen of ordering options includes a delivery purchase option and a store purchase option represent by a corresponding delivery purchase button and a store purchase button (pickup, delivery, fig. 9) for acquiring a screen for providing dealer information (fig. 11, column 8, lines 24-30), and for store purchase, the customer would be able to pick up in the store to save some money or obtained the product immediately. (fig. 11, see minus in price adjustment, and immediate pickups, column 8, line 40i.) Even though the Vallabh reference discloses the use of electronic payment, the reservation of an item and the picking up of it and paying for it in store has been known in the art of selling items.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Hayward to include: an in-store



purchase and pickup option represented by a corresponding an in-store purchase and pickup

Regarding claim 7, Hayward teaches when the option calling button is selected, the controller connects to a predetermined server through a network and causes a screen to be presented, the screen displaying the plurality of options from the server and displays the screen on the display options from the server and displays the screen on the display (column 7, line 54 - column 8, line 12 and column 8:lines 54-63, when BUY NOW button is selected, a connection to server 40 is made, which provides a user screen with a plurality of purchase options: preferred distributor or not preferred distributor).

Regarding claim 8, Hayward teaches the print apparatus consumable purchase system as claimed in claim 3, wherein when the option calling button is selected (column 7, line 54 - column 8, line 12 and column 8:lines 54-63, when BUY NOW button is selected, a connection to server 40 is made, which provides a user screen with a plurality of purchase options: preferred distributor or not preferred distributor), the controller displays the plurality of options on the display (column 8, lines 60-65) and if any option is selected from among the plurality of options, the controller connects to a predetermined server through a network and acquires a order screen to be present (column 8, lines 1-15).

Although Hayward does not mention the presented screen is corresponded to the selected option from the server, it would have been obvious to a person with ordinary skill in the art the order screen that allows user to order the parts would correspond to the user selection of whether the user want to order from the preferred retailer.

Regarding claim 11, Hayward I teaches the print apparatus consumable purchase system as claimed in claim 9, wherein if the delivery purchase button is selected, the controller acquires an ordering screen for ordering the consumable from a predetermined server through a network and displays the screen on the display (column 7, line 54 - column 8, line12, a purchase order screen is acquired from a predetermined server 40 and displayed to the user).

Regarding claim 13, Hayward teaches the print apparatus consumable purchase system as claimed in claim 11, wherein if the delivery purchase button is selected, the controller acquires a screen to be presented, the screen containing one of a selling condition input field for entering selling condition information (column 7, line 66 - column 8, line 2, the user enters the selling conditions) and a selling condition disclosure field for disclosing selling condition information (column 8, lines 9- 11, selling conditions are disclosed on the screen) as the ordering screen from a predetermined server through a network and displays the screen on the display.

Regarding claim 15, Hayward teaches the print apparatus consumable purchase system as claimed in claim 13, wherein at least one of in-stock and out-of-stock concerning the consumable and availability of empty vessel collection service is disclosed in the selling condition disclosure field (column 8, lines 9-10, a confirmation display is sent to the user's display after, column 8, lines 49-53, confirming availability of inventory, which provides the in-stock disclosure).

Regarding claims 18, 20: Hayward teaches the print apparatus consumable purchase system as claimed in claim 11, wherein if the delivery purchase button is selected (fig 4 & column 7, line 54, BUY NOW button), the controller acquires a screen containing a retrieval key information input field for entering user's place retrieval key information as an ordering screen for ordering the consumable from a predetermined server through a network and displays the screen on the display (column 7, line 54 - column 8, line 25, user information concerning user location address is input in ordering screen that has been downloaded from predetermined server 40 after selecting the BUY NOW button), and the controller transmits the user's place retrieval key information entered in the retrieval key information input field to the server (column 8, lines 48-49, server receives user information) so as to receive place- dependent selling condition information extracted by the server based on the user's place retrieval key information (column 8, lines 46-54, based on user information, server 40 processes the order by shipping directly to the user or forwarding the order for local delivery from a retailer local

to the user. In the teachings of Hayward et al. the place- dependent selling condition is delivery method that is based on user location and that changes depending on the location of the shipper in relation to the user. Along with delivery method, a confirmation differs based on user location relative to local distributors) and displays the received place-dependent selling condition information on the display (column 7, line 67 - column 8, line 12, purchase order confirmation is displayed, which would indicate confirmation of delivery method acceptance information).

Regarding claim 23, Hayward teaches the print apparatus consumable purchase system as claimed in claim 11, wherein if the store purchase button is selected, the controller causes a screen to be presented for providing the dealer information from a predetermined server through a network and displays the screen on the display (column 7, line 54 - column 8, line 12 & column 8, lines 54-63, BUY NOW button, i.e. store purchase button, is selected and a display that provides dealer information is provided from a server 40 and for the user).

Regarding claims 29, 32, 34: Hayward teaches print apparatus consumable purchase system as claimed in claim 11, wherein if the store purchase button is selected (fig. 4 & column 7, line 54, BUY NOW button), the controller acquires a screen containing a retrieval key information input field for entering user's place retrieval key information (column 8:lines 48- 49, server receives user information

. that has been input by user and displays the screen on the display (column 7, lines 60-65, purchase order screen is provided to user)), and the controller transmits the user's place retrieval key information entered in the retrieval key information input field to the server (column 8, lines 48-49, server receives user information that has been input by user) so as to receive place-dependent dealer information extracted by the server based on the user's place retrieval key information (column 8, lines 46-54, based on user information, server 40 processes the order by shipping directly to the user or forwarding the order for local delivery from a retailer local to the user. In the teachings of Hayward et al. the place-dependent selling condition is delivery method that is based on user location and that changes depending on the location of the shipper in relation to the user. Along with the delivery method, a confirmation differs based on user location relative to local distributors) and displays the received place-dependent dealer information on the display (column 7, line 67 - column 8, line 12, purchase order confirmation is displayed, which would indicate confirmation of delivery method acceptance information).

Regarding claim 35, Hayward teaches, wherein the consumable is a coloring material cartridge (fig 4, magenta ink level indicates that the consumable is a coloring material cartridge. Also see column 9, lines 40-42).

Regarding claims 36, 38: Hayward teaches a program stored in a computer readable medium (inherent) for causing a computer to function as control means

(column 4, lines 10-20, the program is installed on computer to interact with printer consumable purchasing system shown in fig 2).

Regarding claim 37, Hayward teaches, wherein the consumable is a coloring material cartridge (fig 4, magenta ink level indicates that the consumable is a coloring material cartridge. Also see column 9, lines 40-42)

Regarding claim 39, Hayward/Vallabh discloses the print apparatus consumable purchase system of Claim 1, wherein

the in-store purchase and pick-up button is also configured for reserving the consumable for an in-store purchase from a selected dealer. (it was previously explained that it would be obvious to include a different purchase option button in addition to the buttons already available in the Hayward/Vallabh references and that the reservation of an item is inherent in an in-store pickup)

II. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward in view of Vallabh (US 7,054,832) as applied to claim 23 above, and further in view of Benjamin et al (US 6,113,208).

Regarding claim 26, Hayward teaches the print apparatus consumable purchase system as claimed in claim 23, but do not teach wherein the dealer information contains at least one of address information and map information for locating a dealer place.

However, Benjamin et al. teach dealer information containing an address displayed to the user (column 3, lines 42-45).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have use the address information taught by Benjamin et al. in the provision of dealer information taught by Hayward et al. because it allows the user to locate suppliers nearby for more ordering flexibility.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

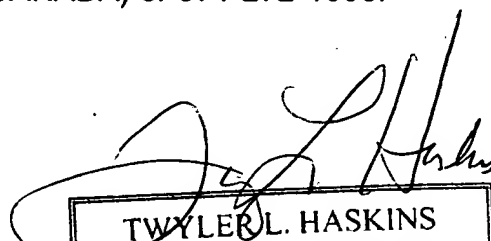
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
YQ

  
TWYLER L. HASKINS  
SUPERVISORY PATENT EXAMINER